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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,296	03/29/2004	Peter B. Risi	1-24403	1805
4859 7590 03/12/2007 MACMILLAN SOBANSKI & TODD, LLC ONE MARITIME PLAZA FIFTH FLOOR 720 WATER STREET TOLEDO, OH 43604-1619			EXAMINER AHMAD, NASSER	
			ART UNIT 1772	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/12/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/812,296	<b>Applicant(s)</b> RISI ET AL.	
	<b>Examiner</b> Nasser Ahmad	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-38 is/are pending in the application.
- 4a) Of the above claim(s) 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group II (Claims 27-38) in the reply filed on 12/19/2006 is acknowledged.

***Rejections Withdrawn***

2. Claims 1-7, 9-17 and 22 are rejected under 35 U.S.C. 112, first paragraph, made in the Office Action of 5/30/2006 has been withdrawn in view of the amendment filed on 10/4/2006.
3. Claims 1-2, 4-7 and 9-10 are rejected under 35 U.S.C. 102(a) as being anticipated by European Patent Application (EP: 1262534) made in the Office Action of 10/4/05 has been withdrawn in view of the amendment filed on 10/4/2006.
4. Claims 1-2, 4-7, 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Hennen (6982107) made in the Office Action of 5/30/2006 has been withdrawn in view of the amendment filed on 10/4/2006.
5. Claims 3, 11-17 and 19-22 are rejected under 35 U.S.C. 103(a) as being obvious over Hennen (6982107) in view of Dickmann (4325855) made in the Office Action of 5/30/2006 has been withdrawn in view of the amendment filed on 10/4/2006.

***Response to Arguments***

6. Applicant's arguments with respect to claims 27-38 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 27, 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Okochi (EP: 1262534).

At first, applicant is informed that because the provisional application fails to provide support for the instant independent claim 1, Okochi is a proper reference under 35 USC 102(b).

For claim 27, Okochi relates to an adhesive product comprising a backing strip of a release liner (paragraph-[0056]) and a gelled adhesive (paragraph-[0008]) on the backing strip.

The intended use phrases such as "**for adhering** wood pieces together", "the adhesive **when fully cured** and adhering the wood pieces together having an adhesive strength of at least about 8 Mpa as measured according to British Standard BS EN 205" 1991, Armex A", etc. have not been given any patentable weight because said phrase are not found to be of positive limitation.

For claim 37, the adhesive is in the form of a layer of the adhesive on the backing strip (abstract).

Regarding claim 38, the product is in the form of a tape (abstract).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 27, 28, 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Hennen (6982107).

For claim 1, Hennen relates to an adhesive product comprising a backing strip of a release liner (col. 2, lines 1-5) and a gelled adhesive (col. 8, lines 58-63) on the backing strip.

The intended use phrases such as "**for adhering** wood pieces together", "**the adhesive when fully cured** and adhering the wood pieces together having an adhesive strength of at least about 8 Mpa as measured according to British Standard BS EN 205" 1991, Armex A", etc. have not been given any patentable weight because said phrase are not found to be of positive limitation.

For claim 28, the adhesive comprises an adhesive resin (such as, polyvinyl acetate) (col. 8, lines 1-11) and would inherently include a gelling agent as the adhesive is formed into a gelled film

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For claim 37, the adhesive is in the form of a layer of the adhesive on the backing strip (abstract).

Regarding claim 38, the product is in the form of a tape (abstract).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 28 and 36 are rejected under 35 U.S.C. 103(a) as being obvious over Hennen (6982107) in view of Dickmann (4325855).

Hennen, as discussed above, fails to expressly teach that the adhesive comprises a gelling agent. Dickmann relates to an adhesive gel comprising an adhesive resin and a gelling agent (abstract). The adhesive includes polyvinyl acetate and polyvinyl alcohol (col. 2, lines 35-40), emulsion or dispersing agent (col. 3, lines 3-5) and ionic salt (col.3, lines 26-28). Therefore, it would have been obvious to one having ordinary skill in the art to utilize dickmann's teaching of using a gelling agent with the adhesive resin in the invention of Hennen with the motivation to provide for stabilizing the adhesive gel.

13. Claims 29, 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hennen in view of Dickmann and Rolf (6096333).

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Hennen and Dickmann, as discussed above, fails to teach that the gelling agent is a gelling colloid. Rolf discloses a gelled adhesive comprising polyvinyl acetate adhesive (col. 5, lines 25-27), gel forming polymer such as listed in lines 12-20, and a humectant such as glycol (col. 5, lines 22-23), which would function as a coalescing solvent.

Therefore, it would have been obvious to one having ordinary skill in the art to utilize Rolf's teaching of using gelling colloid in the invention of Hennen with the motivation to provide a gel with the adhesive.

14. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hennen in view of Dickmann, Rolf and Goodson (6783799).

Hennen, Dickmann and Rolf, as discussed above, fails to teach that the gelling agent comprises colloidal silica and an electrolyte. Goodson discloses adding mixtures of phosphate salt and colloidal silica to an adhesive composition increases the adhesion capacity of the composition (col. 9, lines 43-53). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Goodson's teaching of using colloidal silica and phosphate salt in the adhesive composition in the invention of Dickmann with the motivation to increase the adhesive capacity of the composition.

### ***Conclusion***

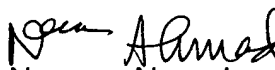
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-

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1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772  
3/7/07

N. Ahmad.  
March 7, 2007.